

REMARKS

The instant Response to Final Office Action is responsive to the Office Action mailed September 22, 2005, which has been made final. Applicants respectfully submit that the claims patentably distinguish over the applied combination of references, and accordingly ask for reconsideration and allowance of the application.

The current status of the claims

Claims 14, 15, and 18 are allowed. (Applicants note that the Summary Sheet of the September 22, 2005 Office Action indicates that these claims "are subject to restriction and/or election requirement." However, the body of the Office Action at pages 7 and 8 expressly states: "Claims 14-15 and 18 are allowed.")

Claims 2-8, 10-12, 16, 17, and 29-30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Camras et al. (U.S. Patent No. 6,784,463, hereinafter "Camras") in view of Sawayama et al. (U.S. Patent No. 6,788,366, hereinafter "Sawayama").

Claim 9 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Camras and Sawayama in further view of Ramdani et al. (U.S. Patent No. 5,838,707, hereinafter "Ramdani").

Claim 13 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Camras and Sawayama in further view of Chua et al. (U.S. Patent No. 6,455,340, hereinafter "Chua").

Claims 19-28 were canceled in previous Amendment A.

The replies to Applicants' remarks are addressed

Independent claims 3 and 29 stand rejected based on the proposed combination of Camras and Sawayama. The Office Action acknowledges that Camras does not show a light-transmissive dielectric layer laterally interspersed with the electrical connecting material, and proposes to combine Camras with Sawayama which is alleged to disclose this feature.

In previous Amendment A, Applicants presented several traversals to this proposed combination, to which the Office Action of September 22, 2005 provided replies. This section sets forth Applicants' response thereto.

(1) *Applicants noted that Sawayama relates to an LCD device, not to a semiconductor device, and hence is non-analogous art. The Office Action replies that*

Sawayama is analogous art insofar as the LCD of Sawayama employs a semiconductor device, namely the thin film transistor (TFT) (4).

A reference is not available under 35 U.S.C. § 103(a) if it is not within the field of the inventor's endeavor and was not directly pertinent to the particular problem with which the inventor was involved. *King Instrument Corp. v. Otari Corp.*, 226 U.S.P.Q. 402 (Fed. Cir. 1985). Sawayama relates to liquid crystal displays, which is not within the field of endeavor of the present application which relates to semiconductor-based flip chip light emitting diode dice. Moreover, Sawayama is not directly pertinent to the particular problem addressed by the present application, namely design of an improved reflective electrode for such a semiconductor-based flip chip light emitting diode dice. Accordingly, Sawayama is not analogous art.

Sawayama does not relate to the TFT, but merely uses a known TFT in a novel LCD display. The skilled artisan designing an electrode for a flip chip light emitting diode die would not look for guidance to the Sawayama patent pertaining to LCD displays, since LCD displays are not within the field of endeavor. At most, the skilled artisan reviewing Sawayama would find a drain electrode (6) of TFT (4) labeled in Sawayama. The skilled artisan would find no teaching about the design of this drain electrode (6) or any other electrode for semiconductor-based light emitting diode dice.

(2) Applicants submitted that Sawayama nowhere discloses or fairly suggests that the dielectric layer (5c) which the Office Action identifies with the light-transmissive dielectric layer of the claims is light-transmissive. The Office Action replies that "the dielectric layer of the instant invention is made of the material which is well known and commonly used for inter-level dielectrics. And these well-known and commonly used inter-level dielectrics are light-transmissive since they are not completely light-reflective or completely light-absorbing." Office Action at page 9.

This showing that the present application discloses a light-transmissive dielectric layer laterally interspersed with the electrical connecting material is irrelevant. The issue is whether Camras or Sawayama, alone or in combination, disclose a light-transmissive dielectric layer laterally interspersed with the electrical connecting material. The Office Action acknowledges that Camras does not show this feature. Office Action at pages 2-3. Accordingly, Applicants again respectfully request that if the proposed combination of Camras and Sawayama is to be maintained, that the forthcoming office paper point out where Sawayama teaches or fairly suggests a light-transmissive dielectric layer laterally interspersed with electrical connecting material.

(3) *Both the first Office Action and the present Office Action allege it would be obvious to the skilled artisan to incorporate the dielectric layer interspersed with electrical connecting material allegedly found in Sawayama into the device of Camras "to protect the reflective electrode." Office Action at page 3. Applicants traversed this alleged motivation by noting that the light transmissive dielectric layer does not serve to protect the reflective electrode – rather, it is part of the reflective electrode. The present Office Action does not dispute this point, but rather replies that "there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art." Office Action at page 10 (quoting *In re McLaughlin*, 170 USPQ 209 (CCPA 1971)).*

The MPEP is clear that, although the references need not expressly articulate a motivation, the Office Action must do so:

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

MPEP § 2142 (underscores added).

Here, the Office Action has articulated an alleged motivation, namely "to protect the reflective electrode." Office Action at page 3. Applicants respectfully submit that neither Camras nor Sawayama disclose either expressly or impliedly such a motivation. Camras, as noted previously, does not mention a light-transmissive dielectric layer laterally interspersed with electrical connecting material. The alleged light-transmissive dielectric layer laterally interspersed with electrical connecting material of Sawayama does not protect the reflective electrode, because the reflective electrode layer (14) is disposed on top of the dielectric film (5c).

Moreover, the Office Action has not presented a convincing line of reasoning as to why the skilled artisan would have found the claimed invention to have been obvious. In the present application, the reflective film (46) is exposed, and is not protected by the underlying light-transmissive dielectric layer (42) laterally interspersed with electrical

connecting material (44). If the artisan fabricated the proposed combination, it would therefore not exhibit the alleged motivating benefit. The artisan cannot be motivated by an alleged motivating benefit which in fact does not exist.

The proposed combination of Camras and Sawayama appears to improperly employ the rejected claims as a blueprint for abstracting individual teachings from the references. See *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 227 U.S.P.Q. 657 (Fed. Cir. 1985). Having abstracted the individual teachings, the Office Action then creates a motivation that is neither found in the references nor factually correct. Such hindsight based on the present application is impermissible. See MPEP § 2142.

CONCLUSION

For the reasons set forth above, it is respectfully submitted that the rejections of claims 2-13, 16, 17, and 29-30 are improper and should be withdrawn. There being no other articulated bases of rejection of these claims, Applicants respectfully request reconsideration and allowance of the rejected claims 2-13, 16, 17, and 29-30.

In the event the Examiner considers personal contact advantageous to the disposition of this case, the Examiner is hereby authorized to call the undersigned at Telephone Number (216) 861-5582.

Respectfully submitted,

FAY, SHARPE, FAGAN,
MINNICH & McKEE, LLP

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Date

Robert M. Sieg
Robert M. Sieg
Reg. No. 54,446
1100 Superior Avenue, 7th Floor
Cleveland, Ohio 44114-2579
(216) 861-5582